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EXAMINER

CARLSON, JEFFREY D

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/858,145
Filing Date: May 14, 2001
Appellant(s): PROHASKA ET AL.

Edward W. Bulchis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/13/2007 appealing from the Office action mailed 4/19/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

"traditional business model" - applicant-admitted prior art, instant specification page 2 lines 10-26 (paragraphs 0004-0005 of the instant PG Pub].

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 68-77 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- Claims 68-69 simply set forth three documents. The content of the documents sets forth intended agreements between different parties, yet these agreement documents are taken to be nothing more than data per se and represent non-functional descriptive material. Claims 70-77 are rejected for similar reasons even though they appear to set forth content on computer media. In essence, these claims are an electronic equivalent of the problematic agreement documents. These claims are taken to represent documentation of a series of intended agreements and information useful for implementing the disclosed system, yet there is no

apparatus programmed with the capabilities of carrying out the functionalities. [See MPEP 2106.01]

Claims 1-3, 5, 6, 11-21 and 24-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over “traditional business model” (applicant admitted prior art).

Applicant provided prior art disclosure as a “traditional business model” in at least instant specification page 2 lines 10-26 [paragraphs 0004-0005 of the published instant application (US PG Pub 20020023030)]. In this applicant-admitted prior art, a client retains an attorney for legal services, the attorney refers the client to an asset manager for providing of financial assistance/benefits to the client. Applicant describes that the attorney in ***most*** jurisdictions is prevented from receiving fees from the benefit provider or from the client for making the referral. It is important to note that according to applicant, not ***all*** jurisdictions have such a regulation. *Inasmuch as pertinent, Examiner notes that the instant invention appears to go against this regulation in that the claimed invention appears to facilitate what amounts to a referral fee from the benefit provider to the attorney, even where prohibited. Nonetheless, the challenges presented by current policy/rules/legal/regulatory hurdles in practicing business will not be taken into consideration by the examiner, nor will any success in overcoming or sidestepping such regulation provide a patentable distinction. Rather, the claims will be evaluated for novelty and obviousness with respect to the technology of the present field of endeavor.*

Regarding claim 1, the claim (and others with similar language) is interpreted to provide the following positive limitations: a method for a first entity servicing a second entity, a referred third entity servicing the second entity, the second entity paying the third entity and the third entity providing compensation to the first entity. Language describing the types or qualities of the entities and language describing why acts are performed do not positively set forth or limit any particular method *steps* that are carried out and are therefore not taken to limit the claims. The traditional business model provides the three entities and the services, but not necessarily transfer of funds from the third entity to the first. However, applicant admits that referral fees are known, but are against regulation in most (i.e. not all) jurisdictions. It would have been obvious to one of ordinary skill at the time of the invention for the *desire* to send a referral fee from 3 to 1, yet to designate any such compensation as other than a referral fee given the illegalities of such. Therefore it would have been obvious to one of ordinary skill at the time of the invention to have provided funds/value from 3 to 1 in the form of a gift or a dinner or an amount of money without calling it a referral fee. Essentially one of ordinary skill would be tempted to provide such a referral fee even if it was met by punishment. It would have been obvious to one of ordinary skill at the time of the invention to have called such a payment as a payment in consideration for the 1st service entity¹ provides to entity². Regarding applicant's language that the compensation "from fees entity³ charges entity²", it would have been obvious to one of ordinary skill at the time of the invention to have paid the compensation using funds earned from any number of sources, including fees from entity². Depositing entity²'s

money into an account and then paying entity1 a compensation from this account is taken to read on the claim language of “from fees the third entity charges the second entity”. Further, it would have been obvious to one of ordinary skill at the time of the invention for entity2 to pay entity3 with the notion that entity3 pass along at least some of the funds to entity1 for the service provided by entity1. In many cases, these referring businesses may be good friends, relatives, or work in the same building and entity2 may find it easier to simply pay entity3 with the notion that some of the funds should be disbursed to entity1 for his efforts. Official Notice is taken that it is common for a person owing several people money to pay the entire sum to one of them with instructions for them to disburse funds to the other deserving recipients. It would have been obvious to one of ordinary skill at the time of the invention to have done so with such a “traditional business model” of attorney and financial consultant for example. Further still it would have been obvious to one of ordinary skill at the time of the invention for entity3 to provide funds from his earnings to entity1 in the situation where entity2 fails to pay entity1 whatsoever. Entity3 may feel it is the right thing to do to at least partially compensate entity1 for his efforts, especially where entity3 has indeed been fairly paid. It would have been obvious to one of ordinary skill at the time of the invention to have made these payments to preserve the goodwill and integrity of the entity1-entity3 relationship or simply because entity3 feels morally compelled to see entity1 gets paid.

Regarding claims 2, 3, 5, 6, 11-21, 37-50, 54, the wide variety of services claimed by applicant are all well known services to provide to a client by way of different

service providers. It would have been obvious to pay a compensation between any two types of service providers.

Regarding claims 24-26, 51-53, applicant admits that periodic payments and proportional value payment schemes are known. It would have been obvious to one of ordinary skill at the time of the invention to have used these with the traditional business model.

Regarding claims 27, 33, 60, it would have been obvious to one of ordinary skill at the time of the invention that any entity can make referrals and/or other payments to any other entity for business purposes.

Regarding claims 28-31, 55-58, 65-67 applicant admits that different entities can enter into affiliated memberships and it would have been obvious to one of ordinary skill at the time of the invention that the entities involved form affiliated relationships so that they can provide team-based servicing. It would have been obvious to one of ordinary skill at the time of the invention that team members provide instructional materials to their clients in order to assist them in understanding the services.

Regarding claims 32, 34, 35, 59, 61, 62, 76, 77, Official Notice is taken that entities that are affiliated in business frequently exchange business information over the Internet by way of remote access to computer systems and by email exchange. It would have been obvious to one of ordinary skill at the time of the invention to have accessed and/or transmitted the business information involved in the proposed business arrangement and services over a network for convenience in order to enable remotely located clients and service entities to conduct business electronically.

Regarding claim 36, 63, a condition cannot limit a method claim. Either the method steps are performed or not. Optional steps or limitations regarding other alternative scenarios do not form part of the performed method steps.

Regarding claim 64, Official Notice is taken that a retiring attorney transfers his clients to another attorney. It would have been obvious to one of ordinary skill at the time of the invention to have transferred the client to another entity when the attorney leaves the affiliated membership or stops practicing law so that the client can continue to receive the needed service.

Regarding claims 68-75, Official Notice is taken that it is well known to draft contracts for business agreements and it would have been obvious to one of ordinary skill at the time of the invention to have documented (on paper and/or electronically) not only the proposed business arrangements between the involved entities and the fees they would pay and receive, but also the assets involved and the details of the services provided as they are rendered.

(10) Response to Argument

[Re: 101] Applicant argues that the documents in claim 68 set forth functional material because the documents themselves establish a relationship between entities and the relationship is functional one. Examiner disagrees. They are merely documents. At best they sit on a table (or sit in electronic storage). They do not *do* anything. They may serve as guidelines for a method to be performed, but the documents alone accomplish nothing.

[Re: 103] Applicant argues that that the claims require a lack of referral fees. Examiner has described how the prior art renders obvious payments from entity3 to entity1 in two ways. The first is in place of a referral fee where do not permit and even where rules do not permit and the second is where entity3 is paid for all services and entity3 distributes funds to entity1. The entities, services and payments for services are all present in the prior art. The only difference between the claim and the art is that referral payments are routed through another party (and not called referrals) - or payments for services are consolidated and forwarded through the third entity. Applicant is essentially playing a shell game with payments; a shell game that is not patentable.

Applicant argues that "it may be 'obvious to try' to compensate an attorney for making a referral", yet the solution claimed is not an obvious one. "Obvious to try" [E] is a rationale explicitly outlined in the KSR Federal Guidelines: [<http://www.uspto.gov/web/offices/com/sol/notices/72fr57526.pdf>]. Applicant has not rebutted with any convincing particularity why the reasons to route payments from entity3 to entity1 outlined in the rejection would be anything but obvious.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jeffrey D. Carlson

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